

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of
SUGIMOTO et al.

Serial No. 10/507,016

Filed: July 18, 2005

For: CURABLE LIQUID RESIN COMPOSITION



Conf. No.: 6554

Atty. Ref.: ES-4676-25

TC/A.U.: 1794

Examiner: E.M. Cole

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REPLY BRIEF UNDER 37 CFR § 41.41

September 29, 2010

Mail Stop Appeal Brief – Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Appellants submit this Reply Brief in response to new issues raised by the Examiner's Answer mailed on August 12, 2010 and to supplement their arguments in the Appeal Brief which was filed on June 18, 2010. Any reply is due within two months from the mailing of the Examiner's Answer. Therefore, this Brief is timely filed; being filed on Wednesday, September 29, 2010.

In the Examiner's Answer, the Section 112 rejection was withdrawn. The only remaining issue in this appeal is the Section 103(a) rejection.

In accordance with M.P.E.P. § 1208 and 37 CFR § 41.37(c), this page contains item (A) and the following pages contains the other required items: (B) Status of claims, (C) Grounds of rejection to be reviewed on appeal, and (D) Argument.

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Reversal of the Examiner's claim rejection by the Board of Patent Appeals and Interferences (the "Board") is respectfully requested.

STATUS OF CLAIMS

Claims 12-25 are the only claims pending, they all stand rejected and are at issue in this appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Question: Under 35 U.S.C. 103(a), was it proper to reject claims 12-25 as allegedly unpatentable over Uchida et al. (WO 01/47824 A1), Shustack (U.S. Patent 5,536,529), Bicerano (Predication of Polymer Properties) and Furukawa (Physical Chemistry of Polymer Rheology)?

Applicants respectfully state that these rejections were not proper and offer the following arguments in support of their statement.

ARGUMENTS

Appellants have presented reasons why claims 12-25 should be considered nonobvious and should be allowed in the Appeal Brief filed on June 18, 2010.

Applicants wish to respond to the Examiner's Answer of August 12, 2010 in this Reply Brief.

Response to Examiner's Answer

In Response to the Examiner's Answer of August 12, 2010, Applicants agree with the Examiner's statement on page 7, lines 18-21 which states that "the rejection does not state that the primary coating of Uchida necessarily or inherently has a modulus of less than 3 MPa, but rather states that Uchida teaches that optical fibers comprising a primary and secondary coating typically have a flexible primary coating." Applicants agree that it is known to people of ordinary skill in the art of Coatings on Optical Fiber that the Primary Coating is supposed to be flexible. Applicants further agree that Uchida does not inherently disclose the claimed primary coating on the optical fibers having the claimed characteristics of a modulus of less than 3MPa.

While Uchida teaches that a primary coating should be flexible, it does not define flexible as having a modulus of less than 3MPa. A Primary Coating with a modulus of less than 3MPa is what is being claimed by Applicant. Applicants disagree with the Examiner's technical conclusion "that "a" flexible coating will have a low modulus" which appears on page 8, line 1 of the Examiner's Answer of August 12, 2010. In the

state of the art of radiation curable primary coatings for optical fiber it is understood that flexibility is based on number of factors, not just one.

Applicants note that the use of the term "flexible" does not lead to the conclusion that a flexible primary coating, must have a low modulus.

High modulus flexible urethane coatings are known since at least 1985 (see, e.g., U.S. Patent 4,520,042 entitled "High-modulus, flexible urethane coating and method of preparation"). Therefore, there is no basis to assume, just because Uchida indicates that a primary coating should be flexible, that the primary coating should necessarily have a low modulus. Further to this point, there is no basis to assume that just because Uchida indicates that a primary coating should be flexible, that the primary coating should have a low modulus and that this low modulus should be less than 3MPa.

Based on the above facts and analysis and arguments, Appellants urge the Board to reverse the Section 103(a) rejection because the claimed invention would not have been obvious to one of ordinary skill in the art at the time it was made.

CONCLUSION

For the reasons discussed above, the Examiner's rejections are improper and they should be reversed by the Board. Appellants submit that the pending claims are in condition for allowance and earnestly solicit an early Notice to that effect.

Respectfully submitted,

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